

REMARKS

The Office Action mailed December 31, 2003 has been carefully reviewed and, in view of the above amendments and following remarks, reconsideration and allowance of the application are respectfully requested.

I. Summary of Claims

Claims 58-80 are currently pending in the application, with claims 58, 66, and 71 being independent claims. Each of the claims were rejected in the outstanding Office Action as follows:

- Claims 58-59, 61-65, 71-73, 76-77, and 80 were rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of International Publication Number WO 91/10376 (hereafter referred to as the PCT Application) and either U.S. Patent Number 2,080,469 to Gilbert or European Patent Application Number 215,974 (hereafter referred to as the European Application);
- Claims 66-67 and 69-70 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of the PCT Application and either Gilbert or the European Application, and further in view of Official Notice; and
- Claims 60, 68, 74-75, and 78-79 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of the PCT Application and either Gilbert or the European Application, and further in view of U.S. Patent Number 5,313,717 to Allen, et al.

II. The Claims Patentably Distinguish Over The Applied Prior Art

Independent Claim 58 is Allowable

Independent claim 58 recites the features of an article of footwear that includes an upper, a sole assembly, and a sealed, fluid-filled bladder. The upper receives a foot of a wearer and includes both a medial side and a lateral side. The sole assembly is secured to the upper. The bladder has a sole portion and an integral foot portion that are in fluid communication. The sole portion is at least partially located within the sole assembly. The foot portion extends outward from the sole portion, and the foot portion extends along at least one of the medial side and the lateral side of the upper. The foot portion includes a first surface and an opposite second surface,

with the first surface generally facing an interior of the footwear and the second surface facing outward from the footwear. In addition, at least one bond is formed between the first surface and the second surface.

The PCT Application discloses an article of footwear having an upper and a sole. One or more sacs are located within the sole, and one or more tubular ducts extend from each sac. The tubular ducts are positioned on an exterior of the upper, and the tubular ducts are in fluid communication with the sacs. One-way valves may be positioned within the tubular ducts to direct fluid flow. Gilbert and the European Application disclose bonds between opposite sides of a bladder for a shoe sole.

The references utilized for an obviousness must teach or suggest each and every limitation in the claims. Independent claim 58 recites that the foot portion, which extends along a side of the upper, forms at least one bond. The fluid-filled structures in both Gilbert and the European Application, however, disclose bonds being formed in horizontal portions of the structures that are intended to extend under an individual's foot and provide support for the foot. There is no teaching or suggestion, however, that bonds may be formed in areas that extend along a side of the foot. In other words, the combination proposed by the Examiner does not disclose the concept of forming bonds in the foot portion.

To establish a *prima facie* case of obviousness, the burden is upon the Examiner to demonstrate reasons why a skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. Accordingly, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination.

The rejection states that (1) the PCT Application does not disclose the foot portion being bonded together and (2) Gilbert and the European Application each teach that upper and lower surfaces of a bladder can be connected together. The mere fact that references can be combined or modified, however, does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In this matter, the rejection presents no line of reasoning as to why a person skilled in the relevant art, when reviewing only the collective teachings of the references, would have found it obvious to selectively pick and choose various elements and/or concepts from the references to arrive at the claimed invention. In other words,

the rejection does little more than cite multiple references to show that one or more elements, when each is viewed in a vacuum, may be known. In other words, the Examiner has attempted to demonstrate obviousness by combining the teachings of the prior art to produce the claimed invention, but without showing any teaching, suggestion, or incentive supporting the combination.

Furthermore, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. The PCT Application discloses tubular ducts. Although the PCT Application does not disclose the specific dimensions of the tubular ducts, one skilled in the relevant art, when reviewing the PCT Application, would conclude that the tubular ducts have a relatively small diameter. Given these dimensions of the tubular ducts, forming the types of bonds that are disclosed in Gilbert and the European Application would effectively seal the tubular ducts and prevent air flow from the sacs to the tubular ducts and vice versa. That is, forming the types of bonds suggested by the Examiner would effectively render the device disclosed in the PCT Application unsatisfactory for its intended purpose.

With regard to the present issue, the Examiner has not properly established the *prima facie* case of obviousness because no proper motivation exists to make the proposed combination. Accordingly, independent claim 58 is allowable over the Examiner's rejection, and claims 59 and 61-65 should be allowable for at least the same reasons. In addition, this deficiency is not remedied by Allen and claim 60 should be allowable for at least the same reasons.

Independent Claim 66 is Allowable

Independent claim 66 recites the features of an article of footwear that includes an upper, a sole assembly, and a sealed bladder. The upper defines a void for receiving a foot of a wearer, and the upper has a medial side and a lateral side. The sole assembly is at least partially formed from a polymer foam material, and the sole assembly is secured to the upper. The bladder encloses a pressurized fluid, and the bladder has a sole portion and an integral foot portion that are in fluid communication. The sole portion is at least partially encapsulated within the polymer foam material of the sole assembly and positioned under at least a portion of the void. The foot portion extends upward from the sole portion and along at least one of the medial side and the

lateral side of the upper. In addition, the foot portion includes a first surface and an opposite second surface. The first surface generally faces an interior of the footwear, and the second surface faces outward from the footwear. At least one bond is formed between the first surface and the second surface.

As with independent claim 58, the references utilized for an obviousness must teach or suggest each and every limitation in the claims. There is no teaching or suggestion, however, that bonds may be formed in areas that extend along a side of the foot. In other words, the combination proposed by the Examiner does not disclose the concept of forming bonds in the foot portion.

The burden is upon the Examiner to demonstrate reasons why a skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. The rejection presents no line of reasoning as to why a person skilled in the relevant art, when reviewing only the collective teachings of the references, would have found it obvious to selectively pick and choose various elements and/or concepts from the references to arrive at the claimed invention. Furthermore, the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. That is, forming the types of bonds suggested by the Examiner would effectively seal the tubular ducts and render the device disclosed in the PCT Application unsatisfactory for its intended purpose, as discussed above with respect to independent claim 58.

Based upon the above discussion, the Examiner has not properly established the *prima facie* case of obviousness because no proper motivation exists to make the proposed combination. Accordingly, independent claim 66 is allowable over the Examiner's rejection, and claims 67 and 69-70 should be allowable for at least the same reasons. In addition, this deficiency is not remedied by Allen and claim 68 should be allowable for at least the same reasons.

Independent Claim 71 is Allowable

Independent claim 71 recites the features of an article of footwear that includes a bladder with a sole portion and a foot portion. The sole portion is positioned in a generally horizontal orientation. The foot portion extends vertically from the sole portion and a bond is formed

between opposite sides. In addition, the foot portion is in fluid communication with the sole portion.

As an initial matter, there is no teaching or suggestion that bonds may be formed in a vertical area of a bladder. In other words, the combination proposed by the Examiner does not disclose the concept of forming bonds in the foot portion. As with the other independent claims, the Examiner has not demonstrated a proper motivation to make the proposed combination and associated modifications to the references. Accordingly, independent claim 71 is allowable over the Examiner's rejection, and claims 72-73, 76-77, and 80 should be allowable for at least the same reasons. In addition, this deficiency is not remedied by Allen and claims 74-75, and 78-79 should be allowable for at least the same reasons.

III. Conclusion

In view of the foregoing, the Applicants respectfully submit that all claims are in a condition for allowance. The Applicants respectfully request, therefore, that the rejections be withdrawn and that this application now be allowed.

This Amendment is being timely filed by facsimile transmission on February 16, 2004. Should additional fees or an extension of time be deemed necessary for consideration of this Amendment, such fees or extension are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for the payment of the requisite fee. If anything further is desirable to place the application in even better form for allowance, the Examiner is respectfully requested to telephone the undersigned representative at (503) 425-6800.

Respectfully submitted,

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